

3 KEY TAKEAWAYS

Third-party Prior Art Submissions at USPTO

35 U.S.C. 122(e) provides a mechanism for third parties to submit printed publications of potential relevance to the examination of a patent application to USPTO. This mechanism is called “third-party pre-issuance submissions”. See: <https://www.uspto.gov/patents/initiatives/third-party-preissuance-submissions>.

However, the mechanism is available only when certain criteria are met. There may be additional avenues for a third party to submit prior art in a patent application prior to issuance and **after** a notice of allowance has been mailed in connection with that patent application.

Three takeaways for third party submissions are:

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A preissuance submission cannot be made in a patent application if a notice of allowance has been mailed in connection with that patent application. This is true even if the notice of allowance is the first action (i.e., AKA first action allowance), or we are within 6 months after the date of publication (e.g., the application went through speedy prosecution).

The prior art reference may be sent (potentially anonymously) to the applicant or their attorney, who would be under a duty to disclose it in an IDS. This option may not be applicable to all situations, and the drawbacks should be carefully considered (e.g., the applicant cites the reference in IDS, Examiner considers, and allows the application despite the reference).

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Wait for the patent to issue. Additional possible courses of action, **after** the patent issues, include:

- a. File an ex parte reexam request or IPR/PGR.
 - b. Use the art as a basis of an opinion letter on invalidity once the patent issues.
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